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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,835	11/14/2003	Fei Mao	THER.001US1	3222
36257	7590	05/12/2005	EXAMINER	
PARSONS HSUE & DE RUNTZ LLP 655 MONTGOMERY STREET SUITE 1800 SAN FRANCISCO, CA 94111			OLSEN, KAJ K	
			ART UNIT	PAPER NUMBER
			1753	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/714,835

Applicant(s)

MAO ET AL.

Examiner

Kaj K. Olsen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 49-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-14-03, 11-8-04 + 9.7.04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Information Disclosure Statement*

1. Some of the references listed on the IDS of 9-7-2004 have been crossed off to avoid duplication. These references were already cited in a different IDS.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 49-73 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6-9, 11-13, 16, 17, 25-31, 34-36, 39, 40, 44, 46-49, 61 and 66-70 of U.S. Patent No. 6,676,816. Although the conflicting claims are not identical, they are not patentably distinct from each other.

4. With respect to claim 49 of the application, claim 1 of patent '816 already set forth the basic complex formula of L, L', L1, L2, M with the set forth choice of L and L' of claim 49 of the instant invention. Patent claim 25 explicitly limited the choice of M to osmium and claim 8 explicitly limited the charged form of the complex (see claim 9) to +1 or +2, and the set forth choices of R'3, R'4, Ra, Rb, Rc and Rd. With respect to particular choice of L1 formula of

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claim 49, patent claim 16 already anticipated the use of said formula. Patent claim 9 also set forth the "dX" portion of the formula. With respect to L2 being a halide, patent claim 13 already anticipated the use of chlorine for L2. Hence the chlorine of patent claim 13 would have been fully encompassed by the halide of claim 1 of the instant invention. With respect to the choice of R<sup>1</sup>, patent claim 6 anticipated the use of C1-C6 alkyl. These various dependent claims of the patent all depend from claim 1 of the patent. Although the patent never had any claim that combined all these various features of dependent claims 6, 8, 9, 13, 16 and 25 simultaneously with claim 1 (and thereby read on claim 49 of the instant invention) because these various modifications were evidenced to individually provide desirable complex modification, one possessing ordinary skill in the art would have been motivated to utilize all of these explicitly set forth dependent features for the complex of claim 1 in order to garner all those desirable modifications simultaneously. Such an obvious modification would have been fully encompassed by claim 49 of the instant invention.

5. Claim 49 of the instant invention is similarly obvious over claims 29, 34, 36, 39, 44 and 46 of the patent for the same reasons given above for claims 1, 6, 8, 9, 13, 16 and 25 above.

6. With respect to claim 50, see patent claim 17 or 40, which specify a C1-C12 alkyl group. A C5 alkyl would have been an obvious choice of 1-12 unit alkyl group.

7. With respect to claim 51, a methyl group would have been choice of alkyl group for R<sub>8</sub> (see patent claim 16 or 39).

8. With respect to claims 52 and 53, see patent claim 16 or 39.

9. With respect to claims 54 and 55, see patent claim 13 or 44.

10. With respect to claims 56 and 57, see patent claim 2, 3, 30 or 31.

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11. With respect to claims 58-60, see patent claim 1, 7, 29 or 35.
12. With respect to claims 61 and 62, see patent claim 11, 12, or 29.
13. With respect to claim 63, this claim is very similar to earlier claim 49 except that claim 63 limits R7 to C1-C12 alkyls, limits R9 and R10 to an unsaturated ring, limits L2 to a chloride, limits R'1 to methyl groups, limits Ra, Rb, Rc, Rd to hydrogens, limits c to +2, limits d to 2, and limits X to chlorides. However, the examiner dealt with most of these modifications for the rejections of claims 50, 53, 55, 57, 60 and 62 above. With respect to limiting d to 2 and c to +2, see patent claim 10 or 38.
14. With respect to claim 64, see rejection of claim 50 above.
15. With respect to claims 65-67, see patent claims 26-28 or 47-49.
16. With respect to claim 68, see patent claim 61.
17. With respect to claims 69-73, see patent claims 66-70.
18. The disclosure is objected to because of the following informalities: The amended paragraph 0001 should be further amended to reflect that the specified application has matured into patent 6,676,816.

Appropriate correction is required.

***Allowable Subject Matter***

19. Pending resolution of the double patenting issues, claims 49-73 would be allowed.
20. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art to that of the instant invention is Feldman et al (USP 6,338,790), Sundelin (USP

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4,421,751), Grinstead (USP 4,382,872) Yu (Macromolecules 1999, 32, pp. 5251-5256), and Gholamkhass (J. Phys. Chem. B 1997, 101, 9010-9021) all teach metal complexes based on pyridyl-imidazoline structure. However, Feldman fails to teach the R9 and R10 forming a fused 5 or 6 membered ring. In addition, applicant set forth during the prosecution of 10/143,300 that Feldman was commonly owned at the time of the invention of 10/143,300 (of which the current application is a continuation thereof). Sunderlin and Grinstead failed to set forth, among other things, the specified L1 unit of claims 49 and 63. Yu and Gholamkhass failed to set forth, among other things, the specified L2 units of claims 49 and 63. These various distinctions between the claims and the prior would not have been obvious variations of the prior art.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaj Olsen whose telephone number is (571) 272-1344. The examiner can normally be reached on Monday through Thursday from 5:30 A.M. to 3:00 P.M. and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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April 18, 2005

A handwritten signature in black ink, appearing to read 'Kaj K. Olsen', with a stylized flourish at the end.

**KAJ K. OLSEN**  
**PRIMARY EXAMINER**